

Remarks / Arguments

Claims 1-3 and 6-9 are pending in this application. Claim 1 has been amended. No new matter has been added.

Claim Objections

Claim 1 had been objected to because in proviso f) the words "the" and "1,3-oxazol" had been run together.

Claim 1 has been appropriately corrected.

Claim Rejections - 35 USC § 112

Claims 1-3 and 7 have been rejected under 35 USC §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In particular, claims 1-3 and 7 have been rejected on grounds that the provisos g) in claims 1-3 lack description in the specification, citing *Ex Parte Grasselli*, et al. 231 USPQ 393.

Applicants respectfully submit that *Ex Parte Grasselli* is not controlling in the present case, because it is a board of appeals decision rather than a court decision, because its facts are dissimilar to those of the present case, and because the board does not appear to have carefully considered whether the original specification could have supported the claims which included the limitations even though the limiting language was not present in the case as filed.

Graselli involved claims to a process for ammoxidation of propane or isobutane to obtain acrylonitrile or methacrylonitrile, using an oxidation catalyst having the formula $A_aB_bC_cSb_dO_x$ in which the capital letter symbols were each defined as one of several recited elements or a mixture thereof, and the subscripts were each defined as a numerical range. The process claim also contained limitations reciting that the process was to be carried out in the absence of sulfur and halogen, and that the catalyst was to be free of uranium and the combination of vanadium and phosphorus.

The decision of the board stated that the negative limitations recited in the claims did not appear in the specification as filed. It does not make clear whether both limitations or only one were absent from the original specification, or if only one was absent, which one. It states that the added express exclusion of certain elements implies the permissible inclusion of all other elements not so expressly excluded, and concluded that such negative limitations in fact introduce new concepts. This statement and conclusion are certainly of questionable validity. The decision does not discuss the number or kind of examples provided in the specification, or any other forms of disclosure which may have been present there. It does not discuss why the disclosure of the specification as originally filed without the limiting language is considered insufficient to support the claims including the limitation(s). Rather, it simply concludes that because the negative limitations recited in the claims were not present in the specification as filed, the description requirement was not met.

It is well-established law that the description requirement may be met even though the exact language employed in amended claims is not present in the specification as filed. In the Grasselli decision the board does not appear to have seriously considered whether the claims including the limitations were or were not supported by the original specification, but instead required the limiting language to be present in the original specification. Accordingly, it is deemed that this decision should not be controlling here.

By contrast, in the present application the applicants have added a proviso disclaiming certain individual species in claims to a genus to avoid prior art, where that genus is expressed in the form of a Markush claim. The controlling case is deemed to be *In re Johnson*, 558 F.2d

1008, 194 U.S.P.Q. 187. *Johnson* related to substantially linear thermoplastic polyarylene polyethers, which were generically claimed in terms of a general formula, the parts of which were defined. The parent application was involved in an interference over two species within the generic, which the applicants lost. In a continuing application, the applicants presented their original generic claims but included provisos, the language of which excluded from the claims the two species lost in the interference (and incidentally also excluded some additional subject matter). The examiner rejected the claims of the CIP as unpatentable in view of a Dutch patent which was a foreign-filed counterpart of the applicant's 1963 parent application. The applicants maintained that they were entitled to the benefit of the filing date of their parent application, and accordingly, that the Dutch patent was not a prior art reference. The examiner and the Board of Appeals maintained that the CIP was not entitled to the benefit of the filing date of the parent application, on the ground that the subject matter of the claims of the CIP was not "described" in the parent case.

On appeal to the United States Court of Customs and Patent Appeals (CCPA), the court reversed the board and held that the CIP was entitled to the benefit of the filing date of the parent application. It stated, "The only inquiry is whether, after exclusion from the original claims of two species specifically disclosed in the 1963 application, the 1963 disclosure satisfies §112, first paragraph, for the limited genus now claimed." The court reviewed the disclosure of the parent application and noted that the applicant was now simply "claiming less than the full scope of his disclosure".

The court continued, "But, as we said in *In re Wertheim*, 541 F.2d 257, 263 191 USPQ 90, 97 (Cust. & Pat.App.1976):

Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable.

It is for the inventor to decide what bounds of protection he will seek. In re Saunders, 444 F.2d 599, 607, 58 CCPA 1316, 1327, 170 USPQ 213, 220 (1971). To deny appellants the benefit of their grandparent application in this case would, as this court said in Saunders:

* * * let form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed.”

The court discussed and distinguished several decisions cited by the board and continued, “The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count.

The board indicated that ‘it is manifestly immaterial’ why appellants limited their their claims. Though it is true that insufficiency under §112 could not be cured by citing the causes for such insufficiency, it is not true that the factual context out of which the question under §112 arises is immaterial. Quite the contrary. Here, as we hold on the facts of this case, the ‘written description’ in the 1963 specification supported the claims in the absence of the limitation, and that specification, having described the whole, necessarily described the part remaining. The facts of the prosecution are properly presented and relied on, under these circumstances, to indicate that appellants are merely excising the invention of another, to which they are not entitled, and are not creating an ‘artificial subgenus’ or claiming ‘new matter’.”

Held: that the appellants’ 1963 disclosure satisfied §112, first paragraph, with respect to the claims at issue, and they were therefore entitled to the benefit of the filing date of their parent application.

This decision stands for the proposition that applicants may excise prior art subject matter from their claims and still satisfy the §112, first paragraph, written description requirement.

In the present application, the applicants are attempting to excise certain prior art compounds from the scope of their generic claims, with the result that they are now claiming less than the full scope of the original disclosure, to which they erroneously thought they were entitled when they filed.

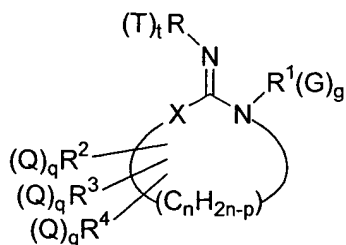
Applicants believe the reasoning given in *In re Johnson* also holds true for the present application. For this reason, reconsideration and withdrawal of the rejection of claims 1-3 and 7 under 35 USC § 112, first paragraph is requested.

Claim Rejections - 35 USC § 102

Claims 1 and 2 have been rejected under 35 USC §102(b) as being anticipated by Ishimitsu (JP 63-41471 A2) on the ground that it discloses 3 compounds that anticipate Applicant's compound claims.

Applicants have deleted from claim 1 Ishimitsu's compounds (*N*-[(2*E*)-3-allyl-4-methyl-5-(4-methylphenyl)-1,3-oxazolidin-2-ylidene]-4-chloro-2-methylaniline, Ishimitsu example no. 53; (4-chloro-2-methylphenyl)[(2*E*)-3-ethynyl-4-methyl-5-(4-methylphenyl)-1,3-oxazolidin-2-ylidene]amine, Ishimitsu example no. 54; and (4-chloro-2-methylphenyl)[(2*E*)-3-isopropyl-4-methyl-5-(4-methylphenyl)-1,3-oxazolidin-2-ylidene]amine, Ishimitsu example no. 55, the names of which have been generated with the program ACD/Name Batch (Network) ver. 6.06 from Advanced Chemistry Development, USA). These deletions are deemed to overcome the rejection under 35 USC §102(b).

Applicants respectfully submit that Ishimitsu does not anticipate claim 2, since Ishimitsu does not disclose a compound having the formula



wherein, *inter alia*, R^2 , R^3 , and R^4 are independently selected from the group consisting of

H;

alkyl of 1 - 10 carbons;

cycloalkyl of 3 - 12 carbons;

alkenyl of 2 - 10 carbons;

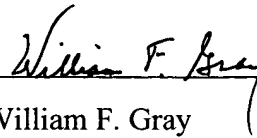
cycloalkenyl of 5 - 12 carbons; and

$=O$, representing two of the groups R^2 , R^3 , and R^4 .

Note that the compounds of the reference contain a substituted phenyl group as R_2 , and that such groups are not within the definition of R^2 , R^3 , and R^4 of present claim 2. For this reason, withdrawal of the rejection of claim 2 under 35 USC §102(b) is requested.

In view of the above amendments and arguments, this application is deemed to be in condition for allowance, and allowance is accordingly requested.

Respectfully submitted,

A handwritten signature in cursive script, reading "William F. Gray", is written over a horizontal line.

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